The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DONALD F. HAMILTON and MICHAEL D. ROSEN

Appeal No. 2000-1577
Application 08/777,958

HEARD: March 5, 2002

Before FLEMING, LALL, and SAADAT, **Administrative Patent Judges.**

FLEMING, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1 through 10, all the claims pending in present application.

The invention relates to the placement of a low frequency audio speaker to effect improved frequency response in the interior of the vehicle with a trunk speaker that occupies negligible useful trunk volume. Figure 1 in the specification is a rear three-quarter view of an automobile showing speaker placement according to an exemplary embodiment of the invention. See page 1 of the specification. Figure 2 is a rear view of the automobile showing speaker placement in accordance with the embodiment of figure 1. See page 1 of the specification. Figure 1 shows a speaker enclosure 9 placed in a rearward section of the trunk 7 of the vehicle 1 above the trunk floor 8 outside any compartment containing the spare tire. See page 2 of the specification. The speaker enclosure 9 is not mounted to the rear deck 3 nor are speaker holes provided in the rear deck. See page 2 of the specification. As shown in the rear view of figure 2, placement of the speaker enclosure 9 is preferably in a corner of the vehicle trunk 7 occupying negligible useful trunk volume. See page 2 of the specification.

The only independent claim 1 is reproduced as follow:

1. An audio speaker system for a vehicle having a passenger compartment, a spare tire compartment, a trunk having a trunk floor, a dividing portion and a rear deck, said dividing portion and said rear deck dividing the trunk and the passenger compartment, said audio speaker system comprising at least one

low frequency speaker disposed within the trunk of the vehicle at the trunk rear in a location spaced from the passenger compartment by the portion of the trunk extending to the front of the said vehicle such that said at least one speaker is clear of the rear deck above said trunk floor and outside said spare tire compartment.

The Examiner relies on the following reference:

Newcomb, D. "Something Fishy" Car Audio and Electronics, (Feb. 1992) pp. 28-32.

Claims 1 through 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Newcomb.

Rather than reiterate the arguments of Appellants and the Examiner, references is made to the briefs[1] and Answer for the respective details thereof.

OPINION

We will not sustain the rejection of claims 1 through 10 under 35 U.S.C. § 103.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a **prima facie** case of obviousness. **In re Oetiker**, 977 F.2d 1443, 1445, 24 USPQ 1443, 1444 (Fed. Cir. 1992). **See also In re Piasecki**, 745 F.2d 1468,

[1] Appellants filed an appeal brief on January 19, 1999. Appellants filed a reply brief on September 29, 1999. The Examiner mailed an office communication on December 15, 1999, stating that the reply brief has been noted and entered.

1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. **In re Fine**, 837, F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellants. **Oetiker**, 977, F.2d at 1445, 24 USPQ at 1444. **See also Piasecki**, 745 F.2d at 1472, 223 USPQ at 788.

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. "In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all of the evidence and arguments." **In re Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. "[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." **In re Lee**, Slip OP 00-1158 page 9. With these principles in mind, we commence review of the pertinent evidence and arguments of Appellants and Examiner.

Appellants argue that Newcomb does not teach or suggest "at least one low frequency speaker disposed within the trunk of the vehicle at the trunk rear in a location spaced from the passenger compartment by the portion of the trunk extending to the front of said vehicle such that said at least one speaker is clear of the rear deck above said trunk floor and outside said spare tire compartment" as recited in Appellant's claim 1. See page 4 of the Appellant's brief. Appellants further argue that the Examiner is using the Appellant's disclosure as a blueprint or a template for proposing the modification to what the reference discloses in an attempt to meet the terms of claims being rejected. See page 5 of the Appellants' brief. Appellants further argue that the Examiner must provide evidence of any factual teachings or suggestions that would lead one of ordinary skill in the art to make the proposed modification. See pages 3, 4 and 5 of Appellant's reply brief.

The Federal Circuit states that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." **In re Fritch**, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), **citing In re Gordon**, 733 F.2d 900, 902, 221 USPQ 1125,

1127 (Fed. Cir. 1984). It is further established that "[s]uch a suggestion may come from the nature of the problem to be solved, leading inventors to look to references relating to possible solutions to that problem." **Pro-Mold & Tool Co. v. Great Lakes Plastics Inc.**, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), **citing In re Rinehart**, 531 F.2d 1048, 1054, 189 USPQ 143, 149 (CCPA 1976) (considering the problem to be solved in a determination of obviousness). The Federal Circuit reasons in **Para-Ordnance Mfg. Inc. v. SGS Importers Int'l Inc.**, 73 F.3d 1085, 1088-89, 37 USPQ2d 1237, 1239-40 (Fed. Cir. 1995), that for the determination of obviousness, the court must answer whether one of ordinary skill in the art who sets out to solve the problem and who had before him in his workshop the prior art, would have been reasonably expected to use the solution that is claimed by the Appellants.

In addition, our reviewing court requires the PTO to make specific findings on a suggestion to combine prior art references. **In re Dembiczak**, 175 F.3d 994, 1000-01, 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999). Our reviewing court states further that the "factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority." **In re Lee**, Slip OP 00-1158 page 9. It is

improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." **W.L. Gore v. Garlock, Inc.**, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983).

Upon our review of Newcomb, we find that Newcomb teaches to place the woofer inside the spare tire compartment. Furthermore, we fail to find any suggestion of placing the woofer in any other portion of the trunk. Furthermore, we find that Newcomb specifically teaches that the placement of the woofer in the spare tire compartment of the trunk is advantageous because it allows for more usable space in the trunk for other luggage. See page 30 of Newcomb. Therefore, we fail to find that the record supports the Examiner's position of specific findings on a suggestion to modify Newcomb to place the woofer outside of the spare tire compartment as claimed by the Appellants.

We have not sustained the rejection of claims 1 through 10 under 35 U.S.C. § 103.

Accordingly, the Examiner's decision is reversed.

REVERSED

MICHAEL R. FLEMING)
Administrative Patent Judge)
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PARSHOTAM S. LALL) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
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MAHSHID SAADAT) INTERFERENCES
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